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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,600	10/04/2001	William H. Wisecarver III	1480-00	1951

35811 7590 04/20/2006

IP GROUP OF DLA PIPER RUDNICK GRAY CARY US LLP
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EXAMINER

ALPERT, JAMES M

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/970,600	WISECARVER ET AL.	
	Examiner	Art Unit	
	James Alpert	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2006 and 22 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following communication is in response to Applicant's amendment and affidavits filed on 01/26/2006 and 10/22/2005, respectively.

Status of Claims

Claims 1-3 and 5-7 are currently amended. Claim 4 is as originally submitted. No claims have been cancelled, nor are any new claims introduced. Therefore, Claims 1-7 are currently pending.

Response to Arguments

Applicant has not advanced any particular arguments **with respect to the 35 U.S.C. §101 and §112 rejections**, however the amendments to the claims appear to be sufficient to overcome these rejections, and they are hereby withdrawn.

With regard to the rejections under 35 U.S.C. §103, the Declaration of William H. Wisecarver III and Mary F. Nugent, filed on October 21, 2005, under 37 CFR 1.131 has been considered but is ineffective to overcome the Armes reference, U.S. Patent Application Publication #20010034720, as discussed below. Therefore, Claims 1-7 remain rejected as stated in the previous office action, and Applicant's request for allowance is respectfully denied.

Claim Rejections - 35 USC § 103

The text of 35 U.S.C §101 can be found in a prior Office action. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Armes, U.S. Patent Application Publication #20010034720.

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37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to demonstrate:

- (A) (actual) reduction to practice of the invention prior to the effective date of the reference; or
- (B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or
- (C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

The examiner has reviewed the affidavit of Applicants, as well as a cursory inspection of the attached Exhibit A. Neither document contains any indicia of performed diligence, so the Examiner understand the submission as intended to demonstrate actual reduction of the invention to practice, prior to the effective date of Armes, which is March 7, 2000.

Please consider the following portions of the MPEP §715.07(1):

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact... Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show...

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). See In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

Applicants have not positively recited the subject matter of the exhibit and the proposed invention in the affidavit, other than to refer to the title of the

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application, must less indicate which facts are being relied upon to support particular claims. While the affidavit and accompanying Exhibit A may contain evidence of actual reduction to practice, Applicants have not cited the particular passages in the accompanying evidence to support particular limitations in the claims, and the Examiner is left to guess what features described in Exhibit A might support reduction to practice. Appropriate correction is required, and consideration might be given to providing line and page number citations as to support in the Exhibit for each of the limitations in the claims.

Thus, the claims, as amended, remain rejected as described herein. **With regard to Claims 1,5**, Armes teaches the method and system comprising:

providing a customer account;
(Page 7-8, Para. 65, describing registering for a secondary transaction number (hereinafter, "STN") is a reasonable interpretation of "lockbox")

verifying electronically that the customer has an established credit card account;
(Page 7-8, Paras. 65-66)

creating an electronic financial account of limited access; and
(Page 8, Para. 68, describing the request for the STN)

authorizing an amount of credit within the financial account of limited access.
(Page 8, Para. 68, describing authorizing limitations on STN use, including amount)

The system and method in Armes describe a comprehensive method and system for a limited use account, traditionally implemented by a credit card provider. Although the Applicant may envision a system where an intermediary third party operates the limited use account, Armes teaches most of the claims when broadly interpreted. Small variations in the claims that are not expressly taught, are simply obvious modifications to the system of Armes. The motivation

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for such modifications is actually found in Armes at (Page 12, Para. 95) which described how the system and method utilizing the STN can be implemented and operated either by the card issuer or an intermediary third-party. This idea is repeated else in the specification at (Page 7, Para. 61) and elsewhere.

With regard to Claims 2,6, Armes teaches the method and system comprising:

creating an account number and access code, and
(The examiner interprets the term "access code" broadly to include a PIN number which is taught at Page 8, Para. 68; Pages 8-9, Paras. 72-73)

accessing a merchant via a computer network; (Page 8, Para. 70)

performing procedures for on-line purchasing; (Page 8, Para. 70)

entering the account number;
(Page 8, Para. 70; Page 9, Para. 73, describing the "drag and drop" onto merchant site)

entering the access code; (Page 8, Para. 68; Page 8, Paras. 75-76)

electronically routing the account number and access code to the provider
(Page 11, Para. 85)

confirming the credit amount and access code; and (Page 11, Para. 86)

routing the dollar amount of the transaction to the credit card issuer.
(Page 11-12, Paras. 91-92)

With regard to Claims 3,7, Armes teaches the method and system comprising:

wiring the amounts of the transaction to the merchant less any discount fee; and
(Pages 11-12, Para. 91, describing the process by which the instruction to be paid is generated)

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debiting the financial account of limited access the amount electronically transferred.(Page 11, Para. 86, describing updates to the STN database following authorization; Pages 12, Para. 92, describing generating cardholder billing)

With regard to Claim 4, Armes teaches the system comprising:

a consumer computer, (Figure 11, Item 1)

a merchant computer, (Page 5, Para. 47)

a credit card bank computer and (Page 5, Para. 47)

a system provider; (Page 12, Para. 95)

the consumer computer in communication with the system provider for opening up an account; (Page 7, Para. 65)

the system provider computer in communication with the credit card bank computer for verifying credit card information; (Page 2, Para. 16)

the consumer computer in communication with the merchant computer for on-line purchasing; (Page 8, Para. 70)

and the system provider computer in communication with the merchant computer for verifying customer information and transaction payment. (Page 11, Para. 91)

Conclusion

THIS ACTION IS FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

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advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Alpert whose telephone number is (571) 272-6738. The examiner can normally be reached on M-F 9:30-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

James M. Alpert
April 17, 2006



HANI M. KAZIMI
PRIMARY EXAMINER